



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/410,494	09/30/1999	KURT W. PIERSOL	74451.P107	6948

7590 06/03/2005

MICHAEL J MALLIE
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD 7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/410,494

Applicant(s)

PIERSOL ET AL.

Examiner

Michael Y. Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,30,31 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25,30,31 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 13, and 25 have been amended.
2. Claims 1-25, 30, 31, and 35-37 have been re-examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2155

3. Claims 1-7, 9, 10, 12-19, 21, 22, 24, 25, 30, 31, and 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Singhal (US 6370527 B1).

INDEPENDENT:

As per claims 1 and 13, Singhal teaches a method (see title) comprising and a machine-readable medium having stored thereon sequences of instructions that, when executed by one or more processors (see 7, lines 31-44), cause: generating, automatically with an electronic system without user intervention (see col.2, lines 17-20), a local network search request (see col.3, lines 15-29) in response to an original search request (see col.1, lines 34-38), the local network search request to cause a search to be performed on electronic documents unconsciously captured by a local network device (see Fig.3), wherein the unconsciously captured documents are stored by a device that is part of a local network and further wherein the unconsciously captured documents are saved in the absence of an explicit command by the user to save the electronic documents and in response to another user specified function associated with the electronic documents (see col.3, lines 30-46), the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request (see abstract and summary); and generating, automatically (see col.2, lines 17-20) with the electronic system without having to wait for a search result of the local network search request from the local network (see col.2, lines 39-42) and in addition to the local network search request (see col.2, lines 43-46), an external network search request (see col.3, lines 15-29) in response to the original search request, the external network search request to cause a search to be performed

on electronic documents available from devices that are part of an external network via a network portal (see Fig.4, #210 and col.4, lines 19-21: network interface) of an external network according to the search parameters of the original search request (see col.1, lines 34-38); and generating a single search report at the electronic device based on the search result of the local network search request and the external network search request (see col.1, lines 54-62).

As per claim 25, Singhal teaches of an apparatus (see title) comprising: a first device to automatically (see col.2, lines 17-20) capture electronic documents from a local network (see col.3, lines 15-29); and an application to be executed by the first device to search the captured electronic documents that have been saved in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents in response to a search request (see col.3, lines 30-46), wherein the application also generates an external document search request in response to the search request (implicit: see col.1, lines 32-41) substantially simultaneously without having to wait for a search result of the local network (see col.2, lines 39-42), wherein the first device transmits the external document search request to a second device on an external network (see col.1, lines 35-38), wherein the second device on the external network performs the external document search request to generate a search of electronic documents from an external network (see col.1, lines 35-38), and wherein the first device combines the local and the external network search results to generate a single search report (see col.1, lines 39-41 & 54-62).

DEPENDENT:

As per claims 2 and 14, Singhal further teaches wherein the local network device comprises a file management appliance (see Fig.3, #130: meta-search engine).

As per claims 3 and 15, Singhal further teaches wherein the file management appliance generates the local network search request and the external network search request (see col.2, lines 43-46).

As per claims 4 and 16, Singhal further teaches wherein the file management appliance performs a search of the unconsciously captured electronic documents in response to the local network search request (implicit: see col.2, line 17-20).

As per claims 5 and 17, Singhal further teaches an Internet (see col.3, line 18) portal performs a search of the electronic documents available via a network portal of an external network in response to the external network search request (implicit).

As per claims 6 and 18, Singhal further teaches wherein the local network search request and the external network search request are generated by a portal appliance in response to the original search request (see Fig.3).

As per claims 7, 19, and 35, Singhal further teaches generating a single search report is generated by combining at least a portion of content from the search results of the local network search request and the external network search request without revealing the associated unconsciously captured electronic documents of the local network to the external network and vice versa (implicit: see Fig.3 and Fig.6, the meta-search engine send the query to number of different search engines then receives the

results of each for sorting, therefore, no data is shared among the different search engines in different networks).

As per claims 9, 21, and 36, Singhal further teaches wherein the single search report is generated by integrating the external and local network search results (see col.1, lines 39-41 and 54-62), wherein the external network search result specifies where and how the local network search result to be integrated into the external network search result in order to form the single search report (implicit: Singhal teaches of a scoring method (see col.10, lines 15-22) of combining the results into a single list, therefore, it is implicit that the scores of both networks specifies where and how the search results of the other network is to be integrated).

As per claims 10 and 22, Singhal further teaches wherein the search report comprises an advertisement selected based on the external network search request (see col.4, lines 41-44).

As per claims 12 and 24, Singhal further teaches generating a third search request in response to the original search request, the third search request to cause a search to be performed on electronic documents available via a second network portal of the external network according to the search parameters of the original search request; analyzing search results of the local network search request, the external network search request, and the third search request; and generating the single search report in response to the analysis of the search results, wherein the single search result is generated in accordance with a format specified by the electronic device (see claim 1,

13, and 25 rejection above; and col.1, lines 36-37: "submits the search query to a plurality of search engine devices")

As per claims 30 and 31, Singhal further teaches wherein external document search is performed by an Internet portal (see col.10, line 40: Internet, and Fig.1, no.150) and wherein the search of captured electronic documents is performed by the device (see col.10, lines 24-34).

As per claim 37, Singhal further teaches wherein the first device further generates a second external network search request to the external network which is performed by a third device on the external network and analyzes the search results of the captured electronic documents, the external document search request, and the second external network search request, wherein the single search report is generated in response to the analysis of the search results and the single search report is generated in accordance with a format specified by the first device (see claim 12 and 24 rejection above and col.3, lines 31-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2155

4. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal (US 6370527 B1) as applied to claims 1, 7, 13, and 19 above, and further in view of Rakavy et al. (US 5913040 A). Singhal teaches all the limitations of claims 11 and 23, except wherein the search report comprises an advertisement selected based on analysis of documents indicated by search results. Rakavy teaches of a search report comprising an advertisement selected based on analysis of documents indicated by search results (see col.1, lines 20-22 & 35-42). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of Rakavy within the system of Walls, by employing search reports comprising an advertisement generated from search results, because this would allow searching systems like Walls' to generate revenue from companies who wish to advertise to customers using such systems, in similar fashion to web site advertising methods currently employed. Furthermore, Singhal suggests the employment of advertising within the multi-search method and program (see col.4, lines 41-44).

5. Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singhal (US 6370527 B1) as applied to claims 1, 7, 13, and 19 above, and further in view of Nasr et al. (US 6263332 B1). Singhal teaches all the limitations of claims 8 and 20, except wherein the search report is one of a Hypertext Markup Language (HTML) document and an Extensible Markup Language (XML). Nasr teaches of a search report is one of a Hypertext Markup Language (HTML) document and an Extensible Markup Language (XML) (see col.2, lines 20-27 and col.8, lines 7-8 & 61-64. It would have been

Art Unit: 2155

obvious to a person of ordinary skill in the art to employ the teachings of Nasr within the system of Singhal by implementing HTML and XML documents within the searching method and program because Singhal teaches that the networks may comprise an Internet and Nasr teaches that XML and HTML are languages for establishing documents in the Internet or World Wide Web.

Response to Remarks

6. Applicant's arguments filed March 4, 2005 have been fully considered but they are not persuasive. *Singhal* teaches each and every element of the claimed invention including the amended limitation, "*wherein the unconsciously captured documents are saved in the absence of an explicit command by the user to save the electronic documents and in response to another user specified function associated with the electronic documents*". *Singhal* teaches in col.3, lines 30-45, of saved information and files on plurality of storage devices, which are searched by the search engines and further teaches that the information and files "may be of interest to a user" which clearly imply that they are saved in the absence of explicit commands by a user to save the electronic documents. Furthermore, the element of "*in response to another user specified function associated with the electronic documents*" is inherent. A user at one time or another inherently stores the information and files that exists within the storage devices. These information and files are not something that just appears when a

storage device is created. Therefore *Singhal* clearly teaches the claimed invention and neither *Rakavy* nor *Nasr* is relied upon to teach the above mention element.

For the reasons above, all remaining dependent claims remain rejected.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

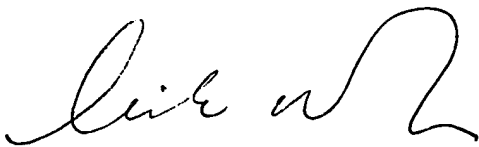
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



May 18, 2005

Bharat Barot.
BHARAT BAROT
PRIMARY EXAMINER